

REMARKS

Applicant has amended claim 10. The claim amendment is supported by the as-filed specification, e.g., paragraphs [0074] and [0084]. No new matter has been introduced. Claims 10-18 remain pending.

Applicant respectfully traverses the 35 U.S.C. § 102(b) rejection of claims 10-18 over U.S. Patent No. 6,300,292 to Konishi et al. ("Konishi").

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131.

Amended claim 10 recites, among other things, at least one compound selected from the group consisting of dihydrocarbyl polysulfides, sulfidized esters, zinc dithiophosphate compounds, zinc dithiocarbamate compounds, molybdenum dithiophosphate compounds, molybdenum thiocarbamate, phosphoric acid esters, acidic phosphoric acid esters, acidic phosphoric acid ester amine salts, phosphorous acid esters and phosphorothionates.

Konishi neither discloses nor suggests any of the above-mentioned compounds, as recited in amended claim 10.

Since Konishi fails to disclose all of the features of amended claim 10, amended claim 10 and its dependent claims are not anticipated by Konishi under § 102(b).

Applicant respectfully traverses the 35 U.S.C. § 103(a) rejection of claims 10-18 over U.S. Patent No. 6,383,992 to Garmier et al. ("Garmier") in view of Konishi.

As discussed above, Konishi fails to disclose the above-mentioned features of amended claim 10. Garmier also provides no disclosure or suggestion of any of the

recited compounds, nor any suggestion of any need to add the recited compounds to its disclosed oil composition. Moreover, no reasonable rationale exists for one of ordinary skill in the art to add such compounds to the oil disclosed by Garmier. The claimed combination, therefore, is not a combination of prior art elements according to known methods to yield predictable results, nor a simple substitution of one known element for another to obtain predictable results, nor application of a known technique to improve a similar device or method in the same way, nor a choice from a finite number of identified, predictable solutions with a reasonable expectation of success. M.P.E.P.

§ 2143.

Moreover, as evidenced by the attached Declaration of Satoshi SUDA under 37 C.F.R. § 1.132 (“Rule 132 Declaration”), if oils for metal working contain both a triester having a total degree of unsaturation of no greater than 3 and a compound selected from the Markush group of sulfur and phosphorus compounds, as recited in amended claim 10, they show unexpected beneficial results such as higher abrasion resistance compared to oils wherein either a total degree of unsaturation of a triester is greater than 0.3 or a sulfur or phosphorus compound used in the oil is not one of the Markush group compounds recited in amended claim 10.

None of the cited references disclose or suggest the recited sulfuric and phosphorous compounds. Accordingly, the cited references also did not predict any beneficial results, e.g., improved abrasion resistance, from the recited sulfur and phosphorous compounds. Absent such teachings in the cited references, using one of the recited sulfur and phosphorous compounds would not have been one of a finite number of predictable solutions to solve the pertinent problems in oils for metal working.

Accordingly, it would not have been obvious to one of ordinary skill in the art to select one of the recited compounds.

Since neither Garmier nor Konishi, alone or in combination, discloses or suggests all of the features of amended claim 10, amended claim 10 is not obvious over the cited references. Claims 11-18 depend from claim 10 and incorporate all of the features of amended claim 10. Claims 11 -18, therefore, also are not obvious at least due to their respective dependence from amended claim 10.

Applicant respectfully traverses the 35 U.S.C. § 103(a) rejection of claims 15-18 over Konishi in view of U.S. Patent Application Publication No. 2002/0035043 to Yokota et al. ("Yokota").

Claims 15-18 depend from claim 10 and incorporate all of the features of amended claim 10. Yokota discloses at paragraph [0084] that sulfuric- and phosphoric-extreme pressure additives may be added to the oil composition disclosed in Yokota; however, Yokota does not disclose or suggest any of the above-mentioned compounds recited in amended claim 10, absent from Konishi. Claims 15-18 also are not obvious at least for the same reasons as amended claim 10.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application, withdrawal of the rejections, and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 9, 2010

By: Hojung Cho
Hojung Cho
Ltd. Rec. No. L0596
(202) 408-4457